

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

Applicants would like to thank the Examiner for maintaining the indication that claims 9, 11, 14 and 16 are allowable.

Claims 1, 6, 7, 12, 17-19 have been further amended, and no new claims have been added. Claims 2 and 21-22 remain cancelled. Accordingly, claims 1, 3-20, and 23-28 remain under consideration.

Claim 1 has been amended solely to further clarify the claim. Applicants have not added new matter. Claim1, as amended, specifies, among other features, that at least two imaging acquisition cycles contain different illuminating conditions and that image data under each illuminating condition is acquired and sent by radio signals (i.e., for further processing outside the body). The claim also specifies that at least two different illuminating variables (i.e., at least a light-emitting amount and light-emitting time), as well as the change in illumination condition resulting from a change in at least one of these variables from one acquisition cycle to the next, be preset. Specifically, Applicants have clarified the claim by using the term "illuminating variable" instead of "illuminating condition" in instances referring to those characteristics of illumination, such as a light-emitting amount or time, which are commonly understood to be variables and not the overall illuminating condition. Independent claims 7, 12, and 17-19 have been similarly amended. Applicants consider the amendments to these claims to properly clarify the claims without changing their scope or introducing any new matter.

In the Office Action, the Examiner has apparently withdrawn the rejections based on the Glukhovsky reference in favor of rejections based on U.S. Patent No. 6,951,536 to Yokoi

et al. (hereinafter “Yokoi”). Specifically, the Examiner rejects claims 1, 3-5, 17-20, 23, and 26-28 under 35 U.S.C. § 102(e) as being anticipated by Yokoi.

The Examiner contends that Yokoi teaches all of the features of the indicated claims. The Examiner specifically refers to the sixth embodiment described in col. 23, as well as associated Figures 30a-b in Yokoi. As shown in the cited portions of Yokoi, the LED 108a intermittently emits light under the effect of a battery 114a before a switch operation signal  $S_k$ , sent extracorporeally, is received by the device to change the quantity of light emitted (see col. 23, lines 38-53 of Yokoi). Figure 30A shows that the intermittent light pulses before the signal  $S_k$  is received do not vary in light-emitting amount, light-emitting time, or time between pulses. The description of Figure 30A in col. 23 of Yokoi also does not teach that the illuminating conditions of the intermittent light emissions before  $S_k$  are changed. Accordingly, even if the intermittent light emissions have been preset before the  $S_k$  signal, they do not include a change in illumination condition.

Figures 30A and 30B show a change in the light-emitting amount only after external signal  $S_k$  is received. It is apparent from the description in Yokoi (particularly, col. 23, lines 47-53) that the purpose of the external signal  $S_k$  is to optimize illumination conditions being observed during the time the first intermittent emissions, described above, are made. Thus, in contrast to claim 1, the different illuminating conditions disclosed in Yokoi, as compared before and after the  $S_k$  signal, are not preset.

Thus, Yokoi may teach, at most, that some parameters of illumination which are not changing may be preset or that some parameters of illumination that are changing are not being changed by a preset condition. In contrast, claim 1 is directed to a change in illumination wherein the change is preset.

In further contrast to claim 1, Yokoi does not anywhere teach or suggest that an image is acquired under different illumination conditions and then transmitted under each condition. Instead, Yokoi teaches the acquisition of a single enhanced image (as shown in col. 23, lines 47-56 therein) after the external  $S_k$  signal is received for the purpose of providing an optimized image. The foregoing further distinguishes claim 1, and hence the remaining claims, over Yokoi.

Accordingly, Yokoi is completely outside the scope of claim 1. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> the indicated claims are not anticipated by Yokoi. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-5, 17-20, 23, and 26-28 under 35 U.S.C. § 102(e) in view of Yokoi.

The Examiner has also rejected claims 6-8, 10, 12-13, 15, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Yokoi in view of U.S. Patent Application Publication No. 2003/0117491 to Avni et al. (hereinafter "Avni"). However, Applicants note that the obviousness rejection under 103(a) makes use of a reference (Yokoi), which is only applicable under section 35 U.S.C. § 102(e). Applicants assert that the assignee of the present application and the assignee of the Yokoi reference were the same at the time the invention was made, and thus, the subject matters of the claimed invention and the Yokoi reference were commonly owned at the time the invention was made. According to U.S. patent law (i.e., 35 U.S.C. § 103(c)), if the 102(e) reference and the claimed invention of the present application were commonly owned at the time the invention was made, then the reference is not applicable in such a rejection. Accordingly, the 103(a) rejection is obviated and claims 6-8, 10, 12-13, 15, and 24-

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

25 are not subject to this rejection. Thus, Applicants respectfully request withdrawal of the rejection of the foregoing claims under 35 U.S.C. § 103(a) in view of Yokoi in combination with Avni.

In view of the above, it is respectfully submitted that the claims are patentable and that this application is in condition for allowance. If the Examiner believes that a telephone conference with Applicants' agents would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Spinelli', with a long horizontal flourish extending to the right.

Thomas Spinelli  
Registration No. 39,533

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza, Suite. 300  
Garden City, New York 11530  
(516) 742-4343  
TS/EG/ech